

U.S. Patent App. Serial No. 10/806,870
Examiner: C.T. Cajilig
Art Unit: 3637
Docket: BS030749

OATH/DECLARATION

Each inventor has been mailed a Supplemental Oath/Declaration providing the mailing address and citizenship for signature. Assignee will submit the Supplemental Oath/Declaration in due course.

U.S. Patent App. Serial No. 10/806,870
Examiner: C.T. Cajillig
Art Unit: 3637
Docket: BS030749

AMENDMENTS to the DRAWINGS

The Specification is amended at paragraph [0018] to obviate the drawing objections cited in the Office Action by deleting reference numerals "141" and "143" from the text of the Specification.

With respect to the "projection" recited in claim 16, Figure 1, for example, illustrates a lip 142 at a top portion 140 of the upwardly extending arm 144. The projection recited in claim 16 refers to the lip 142 of Figure 1, for example. Accordingly, Figure 1, as filed, is believed to adequately show the projection recited in claim 16. The drawing objection referring to the recitation of the "projection" of claim 16 is thus believed obviated by the explanation provided herein.

Claim 18 has been amended to replace "downwardly extending leg" with --channel portion--, thereby obviating the drawing objection based thereon.

Accordingly, all drawing objections are addressed and no Replacement Sheets for the Figures as filed are believed necessary.

U.S. Patent App. Serial No. 10/806,870
Examiner: C.T. Cajilig
Art Unit: 3637
Docket: BS030749

REMARKS

In response to the Office Action dated July 12, 2006, the Assignee respectfully requests entry of the Amendment, with the accompanying Petition for Extension of Time and requisite fee under 37 C.F.R. §1.17(a)(3), submitted herewith. The Assignee further respectfully requests reconsideration of this application based on the remarks and amendments set forth herein. The Assignee respectfully submits that the pending claims distinguish over the cited references to *Edwards, Zimmerman* and *Brooks* whether considered alone or in combination.

Claims 1-20 are pending in this application, claims 3, 11, 19 and 20 having been withdrawn pursuant to the Election of Species acknowledged in the Office Action and concurred with below. Claims 1-20 are amended to comply with claim numbering formatting required in the Office Action, to obviate objections raised in the Office Action, to obviate 35 U.S.C. 112, 2nd paragraph rejections raised in the Office Action, and to overcome the art rejections identified in the Office Action. Support for the claim amendments is found throughout the Specification and in particular at paragraphs [0009] and [0018] with respect to the "wedgeable projection" recited in pending independent claims 1 and 15. Further, the Specification, including the Abstract, is amended to obviate Specification and Drawing Objections set forth in the Office Action. No new matter is submitted. Accordingly, entry and consideration of this Amendment is respectfully requested.

Election/Restriction

Assignee concurs with the Election of Species 3, drawn to claims 1, 2, 4-10 and 12-18, as acknowledged in Items 1-13 of the Office Action. Assignee further concurs that each of claims 1, 2, 4-10 and 12-18 are generic to all Species in this application, as acknowledged in the Office Action. Assignee still further concurs that claims 3, 11, 19 and 20 are presently withdrawn, but subject to rejoinder in the future, should any of the generic claims be allowed, as acknowledged in the Office Action.

U.S. Patent App. Serial No. 10/806,870
Examiner: C.T. Cajilig
Art Unit: 3637
Docket: BS030749

Objection to the Oath/Declaration

In Items 14 and 15 of the Office Action, the Office objects to the Oath/Declaration originally filed with this application for alleged lack of an appropriate mailing address and citizenship for the inventor. Assignee submits that the Declaration filed includes the residence address of the inventor, which residence address is the same as the mailing address of the inventor. The residence address provides a zip code. An appropriate mailing address for the inventor has thus been provided in this application. Nevertheless, each inventor has been mailed a Supplemental Oath/Declaration bearing the mailing address and citizenship of each inventor, and Assignee respectfully submits that the Supplemental Oath/Declaration will be filed in due course to obviate the objection to the originally filed Oath/Declaration. Accordingly, upon filing of the Supplemental Oath/Declaration, withdrawal of the objection to the Oath/Declaration is respectfully requested.

Objections to the Drawings

In Items 16-18 of the Office Action, the Drawings were objected to for failing to show reference numerals "141" and "143", and for allegedly failing to show the "projection" recited in claims 16 and 18. The Specification is amended herein at paragraph [0018] to delete "141" and "143" from the text thereof, thereby obviating the drawing objection in this regard. Moreover, with respect to the "projection" of claim 16, Figure 1 shows such "projection" as the "lip 142" extending from the top portion of the upwardly extending arm 144 (See, Specification at paragraph [0018] and Figure 1. Claim 16 is amended to recite this "lip". The drawing objection in this regard is thus obviated. Finally, with respect to the "projection" of claim 18, claim 18 is amended to replace "downwardly extending leg" with - channel portion--, thereby obviating the drawing objection. Accordingly, all drawing objections having been cured by claim or Specification amendments made herein, withdrawal of all of the drawing objections posed in the Office Action is respectfully requested.

U.S. Patent App. Serial No. 10/806,870
Examiner: C.T. Cajilig
Art Unit: 3637
Docket: BS030749

Objections to the Specification

In Items 19-22 of the Office Action, the Specification is objected to for various reasons. The Specification is hereby amended at paragraphs [0018], [0020], [0022] and [0024] to cure the Specification objections cited in the Office Action. Accordingly, withdrawal of the Specification objections is respectfully requested.

Claim Objections

Claims 1, 2, 4-10 and 12-18 are objected to for claim numbering formatting preferences required by the Office Action. Claims 1-20 are hereby amended to comply with the claim numbering formatting required by the Office Action. Accordingly, withdrawal of the objection to claim 6 is respectfully requested.

Rejection of Claims under 35 U.S.C. §112, 2nd Paragraph

In Items 23-28 of the Office Action, claims 7-10, 13, 15 and 16-18 are rejected as allegedly indefinite under 35 U.S.C. §112, 2nd paragraph for various reasons. Claims 7-9, 13, 15 and 16 are hereby amended to obviate the alleged indefiniteness. Accordingly, withdrawal of the 35 U.S.C. §112, 2nd paragraph rejection of claims 7-10, 13, 15 and 16-18 is respectfully requested.

Rejection of Claims under 35 U.S.C. §102(b)

In Items 29-37 of the Office Action, claims 1, 2 and 12-16 are rejected under 35 U.S.C. §102 (b) as allegedly anticipated by U.S. Patent No. 6,158,180 to Edwards (hereafter "Edwards"). The rejection is respectfully traversed.

A claim is anticipated only if each and every element is found in a single prior art reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). See also DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereafter "MPEP").

Claims 1, 2 and 12-16 cannot be anticipated by *Edwards*. These claims recite features that are not disclosed by *Edwards*. Independent claim 1 is set forth in full above and recites, for

U.S. Patent App. Serial No. 10/806,870
Examiner: C.T. Cajilig
Art Unit: 3637
Docket: BS030749

example, a wire channel device for use with an upper siding panel and a lower siding panel, the wire channel device comprising, *inter alia*, "an upwardly extending arm having a top portion, ..., the outer surface of the top portion having a wedgeable projection to engage and to secure the wire channel device between the upper siding panel and the lower siding panel." Independent claim 15 recites similar features. The "wedgeable projection" recited in each of independent claims 1 and 15 structurally helps to support the wire channel device between upper and lower siding panels and thus differs from the U-shaped hanger mechanism (22) of Edwards.

Although the Examiner is correct that *Edwards* discloses a mounting device (20), the mounting device (20) is comprised of side walls (26, 28) joined by a bridging wall (30) to form a three-sided bight. The three-sided bight is placed over a beam (2) to suspend the mounting mechanism (20) from the beam (2) and behind cladding covers (5a, 5b). See U.S. Patent No. 6,158,180 to Edwards (December 12, 2000) at column 6, lines 38-49, column 7, lines 6-14, and Figure 6. Thus, the mounting device (20) (Figure 6) of *Edwards* relied on in the Office Action does not disclose a wire channel device having a top portion of an upwardly extending arm with a *wedgeable projection* to engage and secure the wire channel device *between* upper and lower siding panels, as recited in independent claims 1 and 15. Claims 2-14 and claims 16-18 ultimately depend from one of claims 1 and 15 and thus incorporate the features thereof. *Edwards* therefore does not and cannot anticipate the combination of the claimed subject matter. Accordingly, withdrawal of the 35 U.S.C. §102(b) rejection of claims 1, 2 and 12-16 based on *Edwards* is respectfully requested.

Rejections of Claims under §103(a)

In Items 38-47 of the Office Action, claims 4 and 10 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over *Edwards* in view of U.S. Patent No. 6,329,599 to Zimmerman. (hereafter "*Zimmerman*"), claims 5, 6, 17 and 18 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over *Edwards* in view of U.S. Patent No. 5,823,655 to Brooks (hereafter "*Brooks*"), and claims 7-9 are rejected under 35 U.S.C. 103(a) as allegedly unpatentable over *Edwards* in view of a court opinion design choice rationale. For the following reasons, these rejections are respectfully traversed.

U.S. Patent App. Serial No. 10/806,870
Examiner: C.T. Cajilig
Art Unit: 3637
Docket: BS030749

1. Edwards "Teaches Away" and Cannot Support a *Prima Facie* Case of Obviousness

Edwards "teaches away" from the pending claims. A reference that 'teaches away' from the claimed invention is a significant factor when determining obviousness. See Manual of Patent Examiner Procedures at §2145 (X)(D)(1) (hereafter "MPEP"). A reference must be considered as a whole, including portions that lead away from the claimed invention. See *id.* at §2143.02; see also *W.L. Gore & Assoc., Inc. v. Garlock, Inc.* 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). "It is improper to combine references where the references teach away from their combination." MPEP at §2145 (X)(D)(2). If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. See MPEP at §2143.01.

The Office Action's alleged *prima facie* case requires impermissible changes to the principle of operation of *Edwards*. As explained above, *Edwards* discloses a mounting device (20) suspended in place over a beam (2) by a bight formed of side walls (26, 28) joined by a bridging wall (30). See, U.S. Patent No. 6,158,180 to Edwards (December 12, 2000) at column 6, lines 38-49, column 7, lines 6-14, and Figure 6. *Edwards* thus limits the hanger mechanism (22) of the mounting device (20) of Figure 6, as relied on in the Office Action, to a three-sided bight placed over a beam (2) in order to position the mounting device (20) as desired. *Id.* The requirement of the bight of *Edwards* thus teaches away from the "*wedgeable projection*" recited in each of the pending independent claims 1 and 15. To modify *Edwards* to eliminate the three-sided bight expressly required therein would alter the principle of operation of *Edwards*. The patent laws, however, forbid such changes to support an obviousness rejection. *Edwards* thus teaches away from the pending claims and cannot be used to support a *prima facie* case of obviousness in combination with any of *Zimmerman*, *Brooks*, or *design choice court opinions*. Accordingly, withdrawal of the 35 U.S.C. §103(a) rejections of claims 4-10, 17 and 18 is respectfully requested.

2. Because No Reasonable Expectation of Success was Cited, the *Prima Facie* Case Is Defective

U.S. Patent App. Serial No. 10/806,870
Examiner: C.T. Cajilig
Art Unit: 3637
Docket: BS030749

The Examiner's alleged *prima facie* case based on a combination of *Edwards* with either of *Zimmerman*, *Brooks*, or *design choice court opinions* is defective. A *prima facie* case for obviousness must include "a reasonable expectation of success". MPEP at §2143. Here, however, no basis for successfully combining *Edwards*, with either of *Zimmerman*, *Brooks*, or *design choice court opinions* to provide a wire channel device having a "wedgeable projection to engage and secure the wire channel device *between* upper and lower siding panels," as recited in pending independent claims 1 and 15, has been cited in the Office Action. All other claims ultimately depend from one of claims 1 and 15. Because the Office has entirely failed to make such a finding, the Office has failed to properly establish a *prima facie* case for obviousness. Withdrawal of the 35 U.S.C. §103(a) rejections of claims 4-10, 17 and 18 is thus respectfully requested.

CONCLUSION

In view of the above, the Assignee submits that all pending claims are patentable. Accordingly, a prompt Notice of Allowance of claims 1-20, including the rejoinder of claims 3, 11, 19 and 20, is respectfully solicited.

Of course, if Examiner Cajilig determines that anything further is desirable to place this application in even better form for allowance, the Examiner is invited to contact the Assignee's representative at (757) 253-5729 or bambi@wzpatents.com.

Respectfully submitted,



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